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Richard Farrar

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MAGINOT, MOORE & BECK, LLP

CHASE TOWER

111 MONUMENT CIRCLE

SUITE 3250

INDIANAPOLIS, IN 46204

EXAMINER

WOODALL, NICHOLAS W

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/524,800
Filing Date: January 17, 2006
Appellant(s): FARRAR ET AL.

Paul J. Maginot
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 16th, 2010 appealing from the Office action mailed March 16th, 2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:
Claims 1-13 are rejected.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being

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maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

5,681,316	DeOrio	10-1997
WO00/00093	Hauri	1-2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims have been amended to require the invention to further include a surgical tool for cutting, which is not supported by the disclosure as originally filed. The applicant directs the examiner to paragraphs 8, 9, 20,

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and 26 and original claims 6 and 7 for support of the newly added limitations (see page 8 of the applicant's arguments filed on January 4th, 2010). The examiner would like to note that the paragraphs of the specification as originally filed as well as claims 6 and 7 as originally filed passively state that the device can be used with a surgical tool, such as a saw blade or a drill bit. For example, paragraph 8 states "...the structural feature can comprise a guide surface which **can be engaged by a cutting tool such as a blade...**" (emphasis added by the examiner). Also, paragraph 9 states "...the structural feature can comprise an opening **in which a drill bit can be** inserted "(emphasis added by the examiner). Furthermore, page 1 line 1 of the specification states "This invention relates to a guide block which can be used in surgery, especially orthopedic surgery, to locate a surgical tool." The disclosure as originally filed never positively recites the invention including the surgical tools. Stating that the guide block is capable of being used with certain surgical tools is not disclosure of the invention including the surgical tools. Therefore, the disclosure as originally filed does not support the guide block in combination with the cutting tools making the limitations new matter.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 and 3-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Hauri (WIPO Publication WO00/00093).

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Hauri discloses a device comprising a guide block, at least one position monitor (17f) for tracking the location of the position indicator to position the guide part relative to a reference point, a signal generator (the computer) connected to the drives to generate positioning signals that are transmitted to the drives to cause movement of the guide part relative to fixation parts of the guide block relative to a reference point, and a surgical tool (12), i.e. a saw blade, having a cutting structure that engages the tool engagement surface of the guide part during use of the surgical tool (see Figure 12). The guide block comprises fixation parts (3, 10a, 10c, etc.) attached to the patient's tissue, a guide part (11) mounted in relation to the fixation parts having a first tool engagement surface (11a) to engage a bone saw, a second tool engagement surface (11b) to engage a drill, at least two drives (5v and 10f) to adjust the position of the guide part relative to the fixation parts in at least two degrees of freedom, wherein the drives include adjusting means, i.e. knobs, accessible outside the housing (see Figure 10), and at least one position indicator (10g) fixed to the fixation parts at a location related to the location of the guide part when attached to the fixation parts (see column 10 lines 26-37). The guide block further includes a housing (10e) in which the drives are located, The guide block further includes connector shafts (for example 10c) that extend from the fixation parts to the guide part, wherein the connector shafts are moved relative to the fixation parts by the drives to adjust the location of the guide part. The fixation part further includes a plurality of openings (for example 3b, 3c, and 3d) that receive bone screws (4) to fix the device the patient's tissue.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2, 4-6, 8, and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeOrio (U.S. Patent 5,681,316) in view of Hauri (WO00/00093).

DeOrio discloses a device comprising a guide block. The guide block comprises fixation parts (12, 16, 20, etc.) attached to the patient's tissue, a guide part (26 and 60) mounted in relation to the fixation parts having a tool engagement surface (97) to engage a bone saw, at least three drives (34, 38, 40, and 42) to adjust the position of the guide part relative to the fixation parts in at least three degrees of freedom, wherein the drives include adjusting means, i.e. knobs,. The guide block further includes connector shafts (for example 14 and 58) that extend from the fixation parts to the guide part, wherein the connector shafts are moved relative to the fixation parts by the drives to adjust the location of the guide part. The fixation part further includes an opening (36) that receive a fastener (28) to fix the device the patient's tissue. DeOrio further discloses at least one drive (42) includes a threaded shaft (88) on the guide part, the examiner is interpreting element 60 as part of the guide part and the treaded shaft of the drive is located on the guide part, that is received by a threaded bore (92) on the fixation part, wherein the drive adjusts the medio-lateral angle of the guide part (see column 3 lines 39-42). DeOrio fails to disclose the device further comprising a computer assistance

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mechanism and a cutting tool. Hauri teaches a device comprising a guide block having drives (5f and 10v), a surgical tool, i.e. a bone saw, and a computer assistance mechanism, wherein the computer assistance includes at least one position monitor (17f), at least one position indicator (10g) attached to the guide block, a signal generator (a computer) connected to motors that operate the drives via a flexible shaft (17a) that imparts rotation motion to the drives from a remote location in order to allow the surgeon to cut the bone of a patient and to allow the surgeon to perform the surgical procedure in an extremely precise manner (column 1 lines 4-7). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of DeOrio further comprising a surgical tool and a computer assistance mechanism in view of Hauri in order to allow the surgeon to cut the bone of a patient and to allow the surgeon to perform the surgical procedure in an extremely precise manner.

(10) Response to Argument

The applicant's argument that the disclosure as originally filed has support for the invention comprising a surgical tool having a bone contacting cutting structure positioned in engagement with the tool engagement guide surface of the guide part during use of the surgical tool is not persuasive. As outlined by the applicant in the argument the disclosure states that the guide block is capable of being used with a cutting blade or a drill bit. However a bone contacting cutting structure is broader than the support for a cutting blade or a drill bit and is not supported by the disclosure as originally filed. The applicant's argument that the Hauri reference does not disclose a

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device having at least one position indicator supported by and fixed relative to the guide part is not persuasive. The applicant is arguing that the position indicator (10g) cannot be physically supported by the guide part (11) because the cutting guide hangs from the position indicator. However, the term "support" is not only directed to physical support. The term "support" also includes functional support and the examiner is using this interpretation of the term "support". The positioning indicator has a function of properly positioning a cutting tool, such as a cutting blade, to cut the knee at proper angles and positions. The guide part supports the position indicator by guiding the cutting tool along a proper angle and position during the cutting procedure. The applicant's argument that the Hauri reference does not disclose a device comprising at least one position monitor configured to track the location of the position, so that the position of the guide part relative to a reference point can be determined is not persuasive. The examiner is using related U.S. Patent 6,554,837 as the translation. Column 9 lines 24-67 and column 10 lines 1-59 disclose that the guide part can be manually moveable by screws 5v and 10f, wherein the screws can also be moved by a motor connected to a computer. The motor also includes rotation sensors 17f that monitors the rotation of screws 5v and 10f, which directly correlates to the position of the position indicator (10g) and the guide part (11).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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/Nicholas Woodall/

Examiner, Art Unit 3775

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